

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1, 3, 6, 8, and 11-33 are pending in this application.
2. Claims 1, 3, 6, 8, and 11-33 are rejected. This action is in response to the applicants' amendment after a non-final and reply filed on September 6, 2007.

### ***Status of Objections***

3. The specification was objected to as not properly identifying the trademark HERCEPTIN. The objection to the specification is hereby withdrawn in view of applicants' amendments to the specification.
4. Claim 17 was objected to as not properly identifying Gadolinium (Gd) as an ion. The objection to Claim 17 is hereby withdrawn in view of applicants' amendments to the Claim.

### ***Status of Rejections***

5. Claims 1, 3, 6, 8, and 11-33 are rejected under 35 U.S.C. 112, first paragraph, as only providing a scope of enablement. Applicant's arguments have been found persuasive. The rejection of Claims 1, 3, 6, 8 and 11-33 are hereby withdrawn in view of applicant's arguments.
6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to define Gadolinium as an ion. The rejection of Claim 17 is hereby withdrawn in view of applicant's amendments to the Claim.
7. Claims 1, 6, 11, and 13 Claim 17 are rejected under 35 U.S.C. 103, as being unpatentable over Moi et. al. in view of US 5,049,667. ('667). Applicant's arguments

Art Unit: 1623

have been found persuasive. The rejection of Claims 1, 6, 11 and 13 are hereby withdrawn in view of applicant's arguments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

***Examiner's Amendment***

8. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Xavier Pillai on November 20, 2007.

The application has been amended as follows:

a. Claims 22-25 and 32 have been cancelled.

***Allowable Subject Matter***

8. Claims 1, 3, 6, 8, and 11-21, 26-31, and 33 are allowed.

***Reasons For Allowance***

9. The following is an examiner's statement of reasons for allowance:

The closest prior art is Moi, et. al., 1998, J. Amer. Chem. Soc. 110, 6266-6267. This literature teaches compounds that are similar in structure to the compounds in the current application. However, Moi et. al. fails to teach or fairly suggest the additional

Art Unit: 1623

methyl group, or fused cyclohexyl ring attached to the DOTA compound core. For this reason, the current application is divergent from the prior art and the claims are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee, and to avoid delays, should preferably accompany the issue fee. Such submissions should clearly be labeled "Comments on the Statements of Reasons for Allowance".

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Examiner, Art Unit 1624

/James O. Wilson/  
Supervisory Patent Examiner  
Art Unit 1624